



PATENT  
Customer No. 22,852  
Attorney Docket No. 96001-0151

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Barclay SAUL et al. ) Confirmation No. 8194  
Application No.: 09/988,215 ) Group Art Unit: 3644  
Filed: November 19, 2001 ) Examiner: Stephen A. Holzen  
For: SYSTEM AND METHOD FOR )  
HOSTING A VIRTUAL GALLERY )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE**

Applicants hereby submit this response to the Office Action mailed February 9, 2004 (hereinafter "the Office Action" or "present Office Action"), the period for response to which extends through May 9, 2004 (a Sunday). Claims 1-4 are currently under consideration. Claims 1 and 3 are the only independent claims.

In the Office Action, the Examiner considered the response submitted December 30, 2003, as persuasive and withdrew the 35 U.S.C. § 103(a) and 35 U.S.C. § 112, ¶ 2 rejections of claims 1-4 as articulated in the previous September 30, 2003 Office Action. Applicants thank the Examiner. In the present Office Action, claims 1-4 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kenney (U.S. Patent No. 6,381,583, hereinafter "Kenney").

Applicants respectfully traverse the rejection of pending claims 1-4 for the reasons provided below. Accordingly, Applicants submit that pending claims 1-4 are in allowable form.

With respect to pending claim 1, the rejection under 35 U.S.C. § 102(e) relies upon inherency for all of the following recited terms: “plurality of gallery accounts” including at least a “first gallery account;” “read-only access” to the “first gallery account;” a “gallery item limit;” “gallery personal information;” and “each of the plurality of gallery accounts is characterized by at least two access modes including the read-only access mode and the qualified access mode.” The Office also characterizes the recited “two representations of the first gallery item and the gallery environment including a two-dimensional representation and a virtual reality representation” as reading on FIGS. 7 and 8 of Kenney. In this regard, Applicants respectfully traverse the assertion by the Office that the above-recited limitations are “inherent” in Kenney, as well as the assertion by the Office that FIGS. 7 and 8 of Kenney disclose the recited “representations of the first gallery item and the gallery environment including a two-dimensional representation and a virtual reality representation.”

With respect to the generous reliance by the Office upon “inherency” in order to account for all of the following terms in Kenney: “plurality of gallery accounts” including a “first gallery account;” “read-only access” to the “first gallery account;” a “gallery item limit;” “gallery personal information;” and “each of the plurality of gallery accounts is characterized by at least two access modes including the read-only access mode and the qualified access mode;” the Office is reminded:

[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter *is necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or

*possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).*

(M.P.E.P. § 2112, emphasis added.) In the present Office Action, the evidence cited by the Examiner to demonstrate that a “plurality of gallery accounts” is necessarily present in Kenney is the “generati[on] [of] a historical purchased item list.” Applicants traverse this reliance upon Kenney’s so-called “historical purchased item list” as evidence that a “plurality of gallery accounts” is necessarily present. According to the express language of the claim, each of the plurality of “gallery accounts” has a:

gallery item limit, gallery personal information, gallery qualification information, a gallery environment, and at least a first gallery item, and where each of the plurality of gallery accounts is characterized by at least two access modes including the read-only access mode and a qualified access mode

In order to conform with the use of “inherency” as the basis for a 102(e) rejection, the evidence cited by the Office (the “historical purchased item list”) must necessarily encompass the descriptive matter cited above (*i.e.*, “gallery item limit, gallery personal information, gallery qualification information, a gallery environment, and at least a first gallery item” as well as being “characterized by at least two access modes including the read-only access mode and a qualified access mode”).

To begin with, Applicants note that although the Kenney specification makes reference to the following “lists” (col. 4/lines 23-27, emphasis added):

Additional lists can be automatically available at the beginning of the interactive virtual shopping session. These include pre-prepared lists of items routinely purchased, items purchased in the past, and items due for reorder based on prior purchase history.

there is nothing in Kenney that suggests that such “lists” are tailored to the personal history of the individual that is in the process of selecting items, as appears to be suggested by the Office in order to find the recited “account.” Rather, Kenney simply refers to such information as “historical.” Applicants remind the Office that a list based simply upon “historical” data may simply contain the “historical” information associated with all shoppers to the store and still fulfill the object suggested in the Kenney disclosure. To the extent that the Examiner is suggesting that a personal shopper history list in Kenney would be an example of an optimal “list,” and is thereby “inherently disclosed,” the Office is reminded that

[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art).

(M.P.E.P. § 2112, underlined emphasis added). For this additional reason, Applicants traverse the apparent use of Kenney’s so-called “historical purchase list” as evidence of the inherent disclosure of the recited “plurality of gallery accounts.”

The Office further cites the following evidence in order to find an asserted disclosure of the recited “request for read-only access to the first gallery account by a first user”: “inherent in that the store is only granted read only access to view personal information and the food choices the shopper has requested.” The Office, however, does not provide any cite to a particular portion of Kenney where a discussion of “store” and “access” to “personal information and the food choices” is found. The most that may be said is that (col. 11/lines 5-15):

Once a list has been created for the products to be purchased, the products can be ordered electronically through the Internet system with instructions for delivery by the store or for pickup by the shopper going to

the store. Payment provisions (preferably secure ones) can also be included in the system.

If the shopper wants to go to the store and go through the aisles to select the individual items himself or herself, the desired list can be printed (e.g., by selecting the "print" button on any of lists 42, 44, 46) and taken to the store by the shopper.

To begin with, Applicants submit that the submission of a list reflecting items currently selected by the disclosed shopper in Kenney to a store is hardly a "*request for read-only access to the first gallery account by a first user*" as suggested by the Office.<sup>1</sup>

Moreover, Applicants submit that the statement "*the store is only granted read only access to view personal information and the food choices the shopper has requested*" is pure speculation by the Office. There is no reason why the owner of a website (i.e., the "store" in Kenney) would so restrict their ability to view "personal information and the food choices the shopper has requested." Why wouldn't the "store" retain their ability to make editorial changes (as may be requested by e-mail, telephone, or other means) to the "*personal information and the food choices the shopper has requested?*" The Office (and Kenney) provides no rationale for adopting such restrictive access. Further still, even assuming some rationale exists, the Office is again reminded:

[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (*reversed rejection because inherency was based on what would result due to optimization of conditions*, not what was necessarily present in the prior art).

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<sup>1</sup> Applicants remind the Office that the Office already associated the "plurality of gallery accounts" with the creation of "historical" lists. Accordingly, even following this logic (which Applicants respectfully traverse) the *submission* of a *current list* does not literally entail a *request for access to a historical list*.

(M.P.E.P. § 2112, underlined emphasis added). For this reason alone, Applicants traverse the Examiner's characterization of Kenney as disclosing the recited: "request for read-only access to the first gallery account by a first user."

The Office again cites to the alleged disclosure of "read only access" by the store in Kenney as teaching the recited: "providing, on the network to the first user, the first gallery account in a read-only access mode." Further still, the Office states (emphasis added):

Where each of the plurality of gallery accounts has a gallery item limit, (inherent in that there is an upper limit on both the amount of money the customer spends shopping, and the stores availability of the requested products), gallery personal information (inherent for on-line purchasers must give contact information, delivery information, payment info), a gallery environment (see Figure 4), and at least a fi[r]st gallery item (products), and where each of the plurality of gallery accounts is characterized by at least two access modes including the read-only access mode and a qualified access mode, (inherent in that the store would have access to the personal account information such as Credit Card, delivery address, but could not alter info such as this and until granted access in Qualified Mode.)

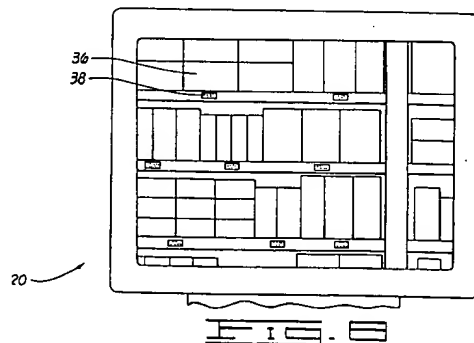
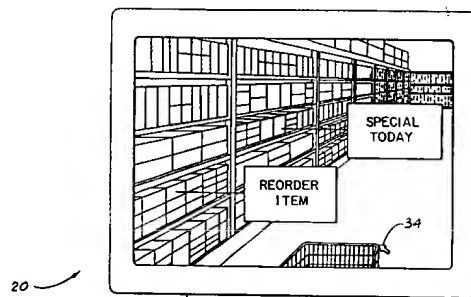
(Office Action, p. 3, emphasis added)

Once again, for the same reasons as given above, Applicants submit that the Office has engaged in considerable speculation in order to find the express terms recited in claim 1 as "inherently" disclosed in Kenney. Applicants submit that this is particularly so where the Office appears to be in the act of constructing rules for how and when a "store would have access to the personal account information such as Credit Card [information]." The Office suggests that such a "store" "could not alter info such as this and until granted access in Qualified Mode." Applicants submit, however, that Kenney is devoid of such rules. Again, while such rules may be prudent, or optimal, in the opinion of the Office,

[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art).

(M.P.E.P. § 2112, underlined emphasis added). Accordingly, for at least this additional reason, Applicant's respectfully traverse the Examiner's use of Kenney in the 102(e) rejection of pending claim 1.

Further still, the Office states that FIGS. 7 and 8 of Kenney disclose the recited "two representations of the first gallery item and the gallery environment including a two-dimensional representation and a virtual reality representation" (Office Action, p. 3). Applicants respectfully traverse the characterization by the Office. For convenience, FIGS. 7 and 8 are reproduced below:



The sole portion of the specification of Kenney that discusses FIGS. 7 and 8 is reproduced below (col. 9/line 57-col. 10/line 17, emphasis added):

The present invention also allows for rotational orientation so that if the shopper is in an aisle, looking in a particular direction, the computer 20 displays that view. Such rotational orientation can be implemented using the control means 14 such as specifically implemented by the arrow keys on a keyboard or by a joystick. Thus, as the shopper travels down the aisle from the end shown in FIG. 4, different data is retrieved from the computer 18 (or from data previously downloaded to the computer 20) to show movement along the aisle as indicated by the scene in FIG. 7. Also shown in FIG. 7 is one technique for identifying to the shopper items to be reordered and on special. Means other than the textual indicators of FIG. 7 can be used; for example, the products can be made to flash or can be highlighted in a predetermined color.

When the shopper stops at a particular section to look at a product, as indicated by left, right, forward or reverse motion such as input through the arrow keys of the keyboard, a more limited, closer view of a section of the aisle can be viewed, such as shown in FIG. 8. Although not shown in the representation of FIG. 8 due to space and lettering constraints, the individual products, such as product 36, appear on the display means as replicas of the actual products and include their labeling in sufficient definition that the labels can be read in at least close-up views. Associated with each product or group of like products is the corresponding price and information label 38 also in detail for reading in at least close-up views.

Applicants respectfully submit that the above disclosure falls far short of the recited “two representations of the first gallery item and the gallery environment including a two-dimensional representation and a virtual reality representation.” The Office appears to be viewing a drawing with an obvious vanishing point, used to portray a depth-of-field, (FIG. 7 of Kenney) as the recited “virtual reality representation,” and another drawing, disclosed simply as a “closer” view of FIG. 7 (consequently, with less ability to appreciate the use of a vanishing point in the drawing), as the recited “two dimensional representation” (FIG. 8 of Kenney). While Kenney arguably discloses a “virtual reality representation” (aside even from the disclosure of FIG. 7),



Applicants respectfully submit that there is no teaching that FIG. 8 is anything other than a close-up view of a shelf—also in virtual reality representation. Applicants direct the Examiner's attention to the description of FIG. 8 in the specification: "Although not shown in the representation of FIG. 8 due to space and lettering constraints, the individual products, such as product 36, appear on the display means as replicas of the actual products and include their labeling in sufficient definition that the labels can be read in at least close-up views." Col. 10, lns. 9-17 (emphasis added) There is no suggestion, inherent or otherwise, that FIG. 8 is any less of a "virtual" experience that one would obtain from FIG. 7. For at least this additional reason, Applicants respectfully traverse the Examiner's rejection of claim 1 as anticipated by Kenney.

With respect to pending claim 2 (dependent upon claim 1), Applicants respectfully traverse the rejection by the Office for the reasons provided above with respect to pending claim 1. Moreover, Applicants again note that the Office makes reference to an "inherent" disclosure based upon an alleged "administrative authority" capacity. Applicants respectfully submit, again, that such "inherent" disclosure is pure speculation by the Office. Nowhere in Kenney is an "administrative authority" capacity discussed, and the Office provides no explanation of the rationale for finding the additional limitations recited in pending claim 2 into such an "administrative authority" capacity. For example, Applicants submit that the Office has not provided any rationale for concluding that the additional limitation, in its entirety:

where the first gallery account in the qualified access mode is configured to allow the second user to modify the associated gallery personal information, the associated gallery qualification information, to add a second gallery item, and to remove the first gallery item.

may necessarily be found in something referred to as an “administrative authority” capacity. For at least this additional reason, Applicants traverse the rejection of pending claim 2 as anticipated by Kenney, inherently or otherwise.

With respect to pending claims 3 and 4, the Office states:

Kenney clearly discloses a host system (see Abstract) a network, a plurality of gallery accounts (*inherent*), gallery items (products), gallery personal information (*inherent*), a gallery environment (figure 4), and at least a gallery item (products), a first local terminal configured for a first user to access the first gallery account in read-only access mode (*inherent*), where each of the gallery items is characterized by at least a virtual size (see Abstract), where the first gallery account in the read-only access mode is configured to allow access to at least two representation of the first gallery item (*see Figures 7 and 8*) and the gallery environment including a two-dimensional representation and a virtual reality representation (see Figures 7 and 8), a second terminal for a second user to access the first gallery account on the host system over the network in qualified access mode (*inherent that user can access from remote terminal*), where the first gallery account in qualified access mode is configured to allow the second user to modify the associated gallery personal information (*inherent that user may alter his purchases or personal information*).

(Office Action, pp. 3-4, emphasis added). In this regard, the Office is apparently relying upon an alleged “inherent” disclosure of a “plurality of gallery accounts,” “read-only access mode,” and “qualified access mode” provided earlier in the Office Action. For the reasons discussed above in connection with the earlier assertions in the Office Action, however, Applicants respectfully traverse the characterization that Kenney discloses, inherently or otherwise, the recited “plurality of gallery accounts,” “read-only access mode,” and “qualified access mode.”

Moreover, the Office again appears to assert that FIGS. 7 and 8 of Kenney disclose the recited two representations: two-dimensional representation and a virtual reality representation.” However, for the reasons provided above in connection with pending claim 1, Applicants

respectfully traverse such a characterization of FIGS. 7 and 8 of Kenney. Further still, and in connection with claim 4, dependent upon claim 3, the Office appears to be asserting the inherent presence of the recited "qualified access mode." Again, for the reasons provided above, Applicants respectfully traverse the characterization that Kenney discloses, inherently or otherwise, all the recited elements of pending claim 4.

**Conclusion**

Accordingly, Applicants submit that claims 1-4 are in allowable form and respectfully request the timely allowance of all pending claims. In the event that there are questions regarding this response, or if the next action on the merits is not an allowance of all pending claims, Applicants respectfully request an interview with the Examiner

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: May 10, 2004

By: \_\_\_\_\_



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